

## REMARKS

The Office Action has been received and reviewed. In the Office Action, claims 1-47 were rejected. In response to the Office Action, Applicant submits the following remarks.

Applicant has also amended claims 1, 16, 30, 41 and 44. The claim amendments have been made to better describe the intended implementation of the invention. Further, an amendment to claim 16 and to claim 17 changed "article" to "source document" so that there is a reference back to the phrase "source document" found in the first portion of claim 16. No other reason should be attributed to the amendments.

If there are questions about this Response, please contact the undersigned. In view of the remarks, Applicant respectfully requests allowance of the claims.

### 1. Rejection Of claims 1-4, 6-11, 15-19, 21-26 and 30-47.

At section 3 of the Office Action, it was argued that claims 1, 16, 30 and 41 are rendered obvious pursuant to 35 U.S.C. 103(a) in view of U.S. patent no. 6,230,325 (Iinuma et al.). Iinuma et al. discloses a system in which a user receives a signal from a broadcasting center. The signal includes "guide information." The "guide information" may include a data base center telephone number and a data base server ID, for designating a data base to be addressed. The "guide information" may include a universal resource locator for the data base center. The "guide information" may be used to connect the user with the data center.

Set forth below are five reasons Iinuma et al. can not support the 35 U.S.C. 103(a) rejection. It is respectfully submitted that any one of the five reasons warrants revocation of the 35 U.S.C. 103(a) rejection.

First Reason - Signal/Source Document

In the present application, original claim 1 required receipt of a signal corresponding to a source document, and analyzing the signal to determine a referenced entity identified in the source document. Amended claim 1 no longer requires analysis of the signal, but instead requires analysis of the source document.

In section 3 of the Office Action, it was argued that Iinuma et al. discloses analyzing a signal to determine a referenced entity identified in the source document. Applicant respectfully disagrees. Although Iinuma et al. may disclose analyzing a signal to identify an entity referenced *in the signal*, there is no suggestion in Iinuma et al. that the referenced entity be identified *in a source document*. This point is applicable not only to the original claim 1, but also the amended claim 1.

In Iinuma et al., the referenced entity is a data base center, and the contact information for that data base center is found in "guide information." Iinuma et al. clearly states the "guide information" is not part of the broadcasted program. Instead, the "guide information" is added to the signal so that the "guide information" arrives along with the broadcasted program. For example, in Iinuma et al. the "guide information"

is appended to the broadcasted program by inserting the "guide information" into a blanking period of an analog television signal, or the "guide information" is superimposed on a digital television signal. See Iinuma et al. at column 2, lines 19-38. When the signal is an analog radio signal, Iinuma et al. discloses that the "guide information" is transmitted in synchronism with the analog radio broadcasting signal. See Iinuma et al. at column 2, lines 39-46. Finally, Iinuma et al. discloses that the "guide information" is transmitted with a digital radio program by multiplexing the "guide information" with the broadcasted program. See col. 2, lines 48-56. It is clear that Iinuma et al. teaches the "guide information" is added to the broadcasted program signal being transmitted. The "guide information" is not part of the broadcasted program.

Being part of the broadcasted program, and being part of the signal corresponding to the broadcasted program are two distinct things. Original claim 1 was written to require an analysis of a signal to determine a referenced entity identified in a source document. Amended claim 1 still requires an analysis, but in amended claim 1, the analysis is made on the source document. It is respectfully submitted that Iinuma et al. does not disclose or suggest the analysis of the original claim 1 or the amended claim 1. Instead, Iinuma et al. discloses what amounts to appending contact information to material being sent to a user. While it may be true that Iinuma et al. discloses analyzing a signal, it does not disclose or suggest analyzing the signal to determine a referenced entity identified in a source document, and Iinuma et

al. does not disclose or suggest analyzing a source document to determine a referenced entity identified in the source document.

Although perhaps more important to original claim 1 than to amended claim 1, it is worth noting that the distinction between the signal and the source document is important. With particular regard for amended claim 1 (and also original claim 1), if the program broadcasted via the Iinuma et al. signal included a reference to the "guide information," the Iinuma et al. method and the Iinuma et al. system would not be able to recognize that "guide information." In contrast, a method according to claim 1 would recognize that information.

Finally, there is no suggestion in Iinuma et al. that the signal or the source document itself be analyzed to determine a referenced entity identified in a source document. As such, the rejection of claim 1 is improper. It is respectfully requested that the rejection of claim 1 be withdrawn.

Since claims 2 through 15 depend from claim 1, claims 2 through 15 include all the limitations of claim 1. Hence, claims 2 through 15 are allowable for the same reasons claim 1 is allowable.

Claim 30 has features that are similar to claim 1. It is respectfully submitted that the arguments given above in support of claim 1 are also applicable to claim 30. As such, Iinuma et al. does not render claim 30 obvious under 35 U.S.C. 103(a). It is respectfully requested that claim 30 be allowed. Since claims 31 through 40 depend from claim 30, claims 31 through 40 include

all the limitations of claim 30. Therefore, claims 31 through 40 are allowable for the same reasons claim 30 is allowable.

Claim 41 has features that are similar to claim 1. It is respectfully submitted that the arguments given above in support of claim 1 are also applicable to claim 41. As such, Iinuma et al. does not render claim 41 obvious under 35 U.S.C. 103(a). It is respectfully requested that claim 41 be allowed. Since claims 42 and 43 depend from claim 41, claims 42 and 43 include all the limitations of claim 41. Therefore, claims 42 and 43 are allowable for the same reasons claim 41 is allowable.

Claim 44 has features that are similar to claim 1. It is respectfully submitted that the arguments given above in support of claim 1 are also applicable to claim 44. As such, Iinuma et al. does not render claim 44 obvious under 35 U.S.C. 103(a). It is respectfully requested that claim 44 be allowed. Since claims 45 through 47 depend from claim 44, claims 45 through 47 include all the limitations of claim 44. Therefore, claims 45 through 47 are allowable for the same reasons claim 44 is allowable.

Second Reason - Data Base

Claim 1 requires that a data base of contact entities be provided. The data base has contact information corresponding to a plurality of contact entities. Further, claim 1 requires that there be a determination as to whether the referenced entity is among the contact entities, and then selecting the contact information corresponding to the referenced entity. It is

respectfully submitted Iinuma et al. does not disclose or suggest these limitations of claim 1.

In Iinuma et al. there is no disclosure or suggestion of a data base of contact information against which a determination is made as to whether a referenced entity is among the contact entities. In Iinuma et al., the "guide information" may be contact information, but the "guide information" is not drawn from a data base having a plurality of contact entities. Perhaps more importantly is the fact that Iinuma et al. does not disclose or suggest a determination as to whether the "guide information" is among the contact entities of the data base.

Instead, in Iinuma et al., once the "guide information" is extracted from the signal, the user terminal is connected to the data base center, and communication between the user terminal and the data base center is established. In Iinuma et al., there is no determination, or suggestion of a determination, as to whether the "guide information" is among a plurality of contact entities contained in a data base. It is respectfully submitted Iinuma et al. does not disclose or suggest the limitations of claim 1.

For the reasons discussed above, Iinuma et al. does not render claim 1 obvious under 35 U.S.C. 103(a). It is respectfully requested that claim 1 be allowed. Since claims 2 through 15 depend from claim 1, claims 2 through 15 include all the limitations of claim 1. Therefore, claims 2 through 15 are allowable for the same reasons claim 1 is allowable.

As discussed above, claims 30, 41 and 44 have features similar to claim 1. It is respectfully submitted that the arguments made in support of claim 1 are applicable to claims 30, 41 and 44, and also the claims which depend from claims 30, 41 and 44. Therefore, claims 30 through 47 are allowable.

Claim 16 requires that a data base be provided. The data base has a plurality of identifiers, each having contact information associated therewith. The contact information corresponds to entities referenced in the source document. Claim 16 also requires that a determination be made as to whether the identifier of the source document is among a plurality of identifiers in a data base. It is respectfully submitted there is no disclosure or suggestion in Iinuma et al. of such an identifier and such a determination being made.

In Iinuma et al., there is no determination about whether a source document identifier, having associated contact information, is among the identifiers of a data base. In Iinuma et al., the "guide information" may be contact information, but the "guide information" does not correspond to entities referenced in a source document. Perhaps most importantly, Iinuma et al. does not suggest that a data base of identifiers be used, and Iinuma et al. does not suggest that a determination be made, about whether the identifier of the source document is among the identifiers of the data base.

Even if the "guide information" could somehow be construed to be both an identifier and contact information, Iinuma et al. does not disclose or suggest determining whether the "guide

information" is among a plurality of "guide information" in a data base. As such, Iinuma et al. teaches away from the invention of claim 16.

Instead, in Iinuma et al., once the "guide information" is extracted from the signal, the user terminal is connected to the data base center, and communication between the user terminal and the data base center is established. In Iinuma et al., there is no determination as to whether the "guide information" is among a plurality of identifiers in a data base. It is respectfully submitted Iinuma et al. does not disclose or suggest the limitations of claim 16.

It might be tempting to consider the "data base center" of Iinuma et al. to be equivalent to the data base of claims 1, 16, 30, 41 or 44. However, doing so would be incorrect. Iinuma et al. does not disclose or suggest determining whether a referenced entity is among the contact entities or the identifiers of the "data base center." Therefore, Iinuma et al. does not disclose or suggest the present invention.

For the reasons discussed above, Iinuma et al. does not render claim 16 obvious under 35 U.S.C. 103(a). It is respectfully requested that claim 16 be allowed. Since claims 17 through 29 depend from claim 16, claims 17 through 29 include all the limitations of claim 16. Therefore, claims 17 through 29 are allowable for the same reasons claim 16 is allowable.

Third Reason - Underlying Logic

Aside from the fact that Iinuma et al. does not disclose or suggest the limitations of the independent claims, the arguments set forth in the Office Action appear to have benefited from hindsight reconstruction. The arguments in the Office Action may be summarized as follows:

- A. There is a feature not found in Iinuma et al..
- B. An Iinuma et al. system would benefit from having that feature.
- C. Therefore, it would have been obvious to add that feature to Iinuma et al..

The logic amounts to arguing that the inventors identified in Iinuma et al. would have benefited from knowing about the ideas disclosed in the present application. While that may be true, such logic can not support a rejection under 35 U.S.C. 103(a). If the logic were sound, the vast majority of patent applications issued today would be invalid. There must be a showing of a suggestion or motivation to modify the teachings of a prior art reference in order to support the obviousness conclusion. There is nothing in Iinuma et al. that suggests the Iinuma et al. system would benefit from having a data base of contact information or a data base of identifiers.

Further, in the Office Action there is no showing where Iinuma et al. provides the motivation for combining a data base of contact information or a data base of identifiers with the Iinuma et al. system. Since Iinuma et al. does not provide the

requisite motivation, and since no other reference was cited for that motivation, it appears the requisite motivation comes from the present application, which is not permitted. The logic is conclusory in nature, and begs at least one of the underlying questions. As such, the 35 U.S.C. 103(a) rejection must be withdrawn.

Fourth Reason - Method Of Selecting Contact Information

At section 3 of the Office Action it is argued Iinuma et al. discloses a method of selecting contact information. Generally speaking, it may be that Iinuma et al. discloses a method of selecting contact information -- the contact information, which is found in the "guide information" is obtained ("selected") by demultiplexing the received signal. It is respectfully submitted that if the act of selecting is demultiplexing, then the thing which is demultiplexed (the received signal) must be a database, because the claims of the present application require that the contact information be selected from a database. It is respectfully submitted that the Iinuma et al. signal transmitted to the user is not a database. Nor is there any suggestion in Iinuma et al. that the Iinuma et al. signal be a database.

It is respectfully submitted that this fourth argument is directly applicable to independent claim 1, and the claims which depend from claim 1. Further, due to the similarity of the independent claims, it is respectfully submitted that the argument is applicable to the other claims of the application. Therefore, it is respectfully requested that the 35 U.S.C. 103(a)

rejection of the claims be withdrawn, and that the claims be allowed.

Fifth Reason - Iinuma et al. Teaches Away From

Iinuma et al. teaches away from the present invention because Iinuma et al. teaches there is no need for a data base having contact information (claims 1, 30, 41 and 44) or a data base of identifiers, the identifiers having associated contact information (claim 16). Iinuma et al. provides the contact information to the user as part of the received signal. The contact information is known from the received signal. Iinuma et al. does not disclose or suggest how the user would contact the data base center if the contact information was missing from the signal. Iinuma et al. has no need for a data base having contact information and no need to determine whether a referenced entity is among the contact entities in the data base. Having no need for these things, it is wrong for the Office Action to include arguments to the effect that it would have been obvious to include a database with contact information in the system disclosed by Iinuma et al.

The present invention is very different from Iinuma et al. For purposes of further illustrating how Iinuma et al. teaches away from the present invention, it may be helpful to discuss Iinuma et al. from a different perspective. The present invention does not need to have contact information in the signal. This fundamental difference between Iinuma et al. and the present invention gives rise to the fact that in the present invention (1) a data base of contact entities is provided, and

(2) a determination is made whether a referenced entity identified in a source document is in the data base. Unlike the present invention, Iinuma et al. does not have a data base of contact entities being provided, and Iinuma et al. does not have a determination being made as to whether a referenced entity identified in a source document is in the data base. Further, there is no suggestion in Iinuma et al. that these two features should be provided. If Iinuma et al. teaches anything, it teaches there is no need to have a database having contact information.

Perhaps an example of how the present invention might be applied will help illustrate the magnitude of the differences between Iinuma et al. and the present invention. In an embodiment of the invention, a person might read an on-line article about a new traffic signal being proposed for the individual's town. The article might quote a member of the town council, and the reader might want to provide the council member with her support for the views the council member expressed in the article. Most such articles do not provide contact information for individuals quoted in the article. In this example, the reader would be required to engage in what might amount to a large amount of work and time to locate the town council member's contact information. Iinuma et al. provides no solution to this problem. However, the present invention provides an elegant solution to this problem.

Even if we assume there is motivation to provide an Iinuma et al. system user with contact information corresponding to a plurality of contact entities (as the Office Action would have us

believe), Iinuma et al. teaches that such contact information should be provided in the signal. Iinuma et al. is based on the assumption that the contact information is present in the received signal. If Iinuma et al. were to be augmented to provide the user with contact information corresponding to a plurality of contact entities, then Iinuma et al. teaches one having ordinary skill in the art to include the contact information in the received signal. The present invention does not call for such measures. Consequently, Iinuma et al. is at odds with the claims of the present application.

For this reason, it is respectfully requested that the rejection of claims 1 through 47 be withdrawn, and that claims 1 through 47 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted a full and complete response to the Office Action has been made. The claims are in condition for allowance, and allowance of the claims is respectfully requested.

The Applicant believes that no fee is due with this Response. If a fee is due, please charge Deposit Account No. 08-2442. Further, Applicant believes that no extension of time is necessary to file this Response. However, if an extension of time is needed, please consider this as a petition for a one-month extension of time.

The Examiner is invited to call applicant's attorney if any questions remain following review of this response. If it will

Response To Office Action  
Pat. App. Serial No. 09/759,536  
Attorney Ref. No. 31215.0002  
Page 29

help, the undersigned is willing to explain by telephone or in person, the reasons the claims are allowable.

Respectfully submitted,



---

R. Kent Roberts  
Attorney for Applicant  
Registration No. 40,786

Date: April 21, 2004

Hodgson Russ LLP  
One M&T Plaza, Suite 2000  
Buffalo, NY 14203-2391